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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-819,308	03-27-2001	Mathieu Hubertus M. Noteborn	4820US	4047

24247 7590 07-24-2002

TRASK BRITT  
P.O. BOX 2550  
SALT LAKE CITY, UT 84110

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 07/24/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/819,308

Applicant(s)

NOTEBORN ET AL.

Examiner

Joseph Woitach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

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### **DETAILED ACTION**

This application filed March 27, 2001, claims benefit to foreign application 00201108.8 filed March 27, 2000 with the EP.

Applicants' preliminary amendment filed March 27, 2001, paper number 6, has been received and entered. Claims 4, 5, 12 and 13 have been amended. Claims 1-21 are pending and currently under examination.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 18 and 17, drawn to an isolated nucleic acid sequence and functional equivalent thereof, as set forth in SEQ ID NO: 1, classified in class 536, subclass 23.5.
- II. Claims 1-9, 18 and 17, drawn to an isolated nucleic acid sequence and functional equivalent thereof, as set forth in SEQ ID NO: 9, classified in class 536, subclass 23.5.
- III. Claims 10-12, 14 and 17, drawn to an isolated Apoptin-associating proteinaceous substance and functional equivalent thereof, as set forth in SEQ ID NO: 2, classified in class 530, subclass 350.

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- IV. Claims 10-12, 14 and 17, drawn to an isolated Apoptin-associating proteinaceous substance and functional equivalent thereof, as set forth in SEQ ID NO: 10, classified in class 530, subclass 350.
- V. Claim 13, drawn to an antibody which recognizes an isolated Apoptin-associating proteinaceous substance or functional equivalent thereof set forth in SEQ ID NO: 2, classified in class 424, subclass 130.1.
- VI. Claim 13, drawn to an antibody which recognizes an isolated Apoptin-associating proteinaceous substance or functional equivalent thereof set forth in SEQ ID NO: 10, classified in class 424, subclass 130.1.
- VII. Claims 15, 16, 19-21, drawn to a method of inducing apoptosis in a cell or in a subject comprising administering a polynucleotide or functional equivalent thereof set forth in SEQ ID NO: 1, classified in class 514, subclass 44.
- VIII. Claims 15, 16, 19-21, drawn to a method of inducing apoptosis in a cell or in a subject comprising administering a polynucleotide or functional equivalent thereof set forth in SEQ ID NO: 9, classified in class 514, subclass 44.
- IX. Claims 15, 16, 19-21, drawn to a method of inducing apoptosis in a cell or in a subject comprising administering a protein or functional equivalent thereof set forth in SEQ ID NO: 2, classified in class 435, subclass 7.1.

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- X. Claims 15, 16, 19-21, drawn to a method of inducing apoptosis in a cell or in a subject comprising administering a protein or functional equivalent thereof set forth in SEQ ID NO: 10, classified in class 435, subclass 7.1.
- XI. Claims 15, 16, 19-21, drawn to a method of inducing apoptosis in a cell or in a subject comprising administering a cell transformed with a polynucleotide or functional equivalent thereof set forth in SEQ ID NO: 1, classified in class 514, subclass 44.
- XII. Claims 15, 16, 19-21, drawn to a method of inducing apoptosis in a cell or in a subject comprising administering a cell transformed with a polynucleotide or functional equivalent thereof set forth in SEQ ID NO: 9, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case each of the different inventions are drawn to structurally different materials. The polynucleotide of groups I and II are physically different from the protein encompassed by groups III-VI. Further, the proteins of groups III and IV are different than the antibody that binds them as set forth in groups

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V and VI. Additionally, each of the specific sequences set forth in the SEQ ID NOs are different and unique providing inherent properties to each of the inventions in each of groups I-VI.

Inventions VII-XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case each of the different inventions are drawn to methods which require different materials to practice, and require different method steps to practice. The polynucleotide used in groups VII and VIII are physically different from the proteins used in the methods of encompassed by groups IX and X, or the cells used in groups XI and XII. Additionally, each of the specific sequences set forth in the SEQ ID NOs are different and unique providing inherent properties to each of the inventions in each of groups VII-XII.

Inventions I-IV and VII-X, respectively, are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case each of the specific polynucleotide sequences can be used as hybridization probes and each of the proteins can be used to generate antibodies.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

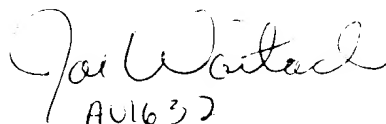
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Pauline Farrier whose telephone number is (703)305-3550.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach

  
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